

REMARKS

Applicant submits the foregoing amendments and the following remarks further to the Amendment under 37 C.F.R. § 1.116 filed March 24, 2005. Applicant respectfully requests full and detailed consideration of the Amendment under 37 C.F.R. § 1.116 filed March 24, 2005.

With respect to the rejection under 35 U.S.C. § 112, first paragraph, Applicant respectfully maintains that “physical addresses in a land track are allocated discontinuously from physical addresses in a groove track in each of the recording layers” of claim 22 is supported by the specification. As disclosed, for example, at page 18, lines 12-20, and Figure 1, the physical addresses on the optical disk are allocated in the order of the groove track 1A of the first recording layer 1, the groove track 2A of the second recording layer 2, the land track 1B of the first recording layer 1 . . .” Thus, as shown in Figure 1, the last physical address of the groove track 1A is followed by the first physical address of the groove track 2A, and the last physical address of the groove track 2A is followed by the first physical address of the land track 1B. That is, the last physical address of the groove track 1A is continuous with the first physical address of the groove track 2A, and the last physical address of the groove track 2A is continuous with the first physical address of the land track 1B in Figure 1. As a result, the last physical address of groove track 1A is discontinuous with the first physical address of land track 1B because the physical addresses of groove track 2A are therebetween. As such, Applicant respectfully maintains that “physical addresses in a land track are allocated discontinuously from physical addresses in a groove track in each of the recording layers” as recited by claim 22 is supported by the specification.

The Examiner notes that the term “discontinuously” does not appear in the specification. In doing so, the Examiner cites MPEP § 608.01(o) to support his position. However, MPEP § 608.01(o) instructs that “an applicant is not limited to the nomenclature using in the application as filed.” Moreover, MPEP § 2163 instructs that “each claim must be expressly, implicitly or inherently supported” (emphasis added), and MPEP § 2163.01 instructs that “a rewording of a passage where the same meaning remains intact is permissible.” Thus, Applicant respectfully submits that the exact terminology need not appear in the specification to provide support for the claim. Applicant respectfully maintains that one of ordinary skill in the art would recognize the claimed invention from the specification, and therefore, Applicant respectfully maintains that “physical addresses in a land track are allocated discontinuously from physical addresses in a groove track in each of the recording layers” as recited by claim 22 is supported by the specification.

With respect to rejection under 35 U.S.C. § 103, the Applicant respectfully understands that limitations of the specification are not read into the specification. However, as set forth in the Amendment under 37 C.F.R. § 1.116 filed March 24, 2005, Applicant respectfully submits that the combination of *Ito* and *Horimai* does not teach or suggest the claimed invention. Moreover, as previously asserted, Applicant respectfully asserts that the Final Office Action does not rely on *Horimai* to teach the deficiencies of *Ito* noted in the Amendment under 37 C.F.R. § 1.116 filed March 24, 2005, and therefore *Horimai* cannot remedy these deficiencies of *Ito*. As such, contrary to the assertion of the Advisory Action, Applicants do not argue the applied references individually in the Amendment under 37 C.F.R. § 1.116 filed March 24, 2005 but rather the combination of the applied references.

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: May 26, 2005

By: 

Robert J. Goodell
Reg. No. 41,040

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-3001